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March 28, 2008

Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Renewed Petition Under 37 CFR 1.137(b) for
Revival of Unintentionally Abandoned Patent Application
Application No. 09/403,894 filed October 26, 1999
Seiji Motojima, et al., Inventors
Our File: 087711-000000US

Madam and/or Sir:

Attached is a renewed Petition for the revival of the above-referenced unintentionally abandoned patent application and responds to the Decision on Petition dated January 29, 2008 which requires an explanation of:

- (1) the delay in reply that originally resulted in the abandonment; and
- (2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application.

The entire delay, including specifically the delays identified under (1) and (2) above, was unintentional, as is set forth in the attached Petition for revival of unintentionally abandoned patent application, the Documents in Support of Renewed Petition, and the Declarations of J. Georg Seka, Jane H. Welch, Lata Olivier and Justin K. Emerson.

The attached Petition and accompanying documents and Declarations demonstrate that both delays were unintentional and resulted from a succession of errors and misunderstandings which culminated in the lengthy delay.

In view thereof, favorable consideration and grant of this Petition at an early date is requested.

If it is believed a telephone conference would be helpful, please telephone the undersigned at (415) 273-4730 (direct dial).

Respectfully submitted,

J. Georg Seka
(email: jgs@townsend.com)

JGS:jhw
Enclosures
61306153 v1



Express Mail" Label No. EV 251377030 US
Date of Deposit: March 28, 2008

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to
Attention: Office of Petitions, **Mail Stop Petition**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

TOWNSEND and TOWNSEND and CREW LLP

By: _____

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

SEIJI MOTOJIMA, ET AL.

Application No. 09/403,894

Filed: October 26, 1999

For: METHOD AND APPARATUS FOR
MANUFACTURING CARBON FIBER
COILS

Customer No. 20350

Confirmation No.

Examiner: Stuart L. Hendrickson

Technology Center/Art Unit: 1754

RENEWED PETITION FOR
REVIVAL OF
UNINTENTIONALLY ABANDONED
PATENT APPLICATION

San Francisco, CA 94111
March 28, 2008

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Renewed Petition for the revival of the above-captioned patent application is submitted in response to the Decision on Petition dated January 28, 2008 ("Decision"). The original Petition was dismissed, and a two-month term for requesting reconsideration by filing this Renewed Petition was set and ends on March 29, 2008.

In view of the long delay between the initial abandonment of this application and the original Petition filed March 23, 2007, in order to grant this Petition the Decision required to

show to the satisfaction of the Director that:

- (1) the delay in reply that originally resulted in the abandonment of this application and
- (2) the delay in filing an initial Petition pursuant to 37 CFR 1.137(b) to revive the application were unintentional.

Attached in support of this Petition are:

- (1) Documents in Support of Renewed Petition Under 37 CFR 1.137(b) for Revival of Unintentionally Abandoned Patent Application, including Exhibits A-F and H-K and Exhibits 1-9 attached thereto, the contents of which are briefly summarized therein, arranged in a three-ring binder attached hereto;
- (2) Declaration of Lata Olivier in Support of Renewed Petition for Revival of Unintentionally Abandoned Patent Application ("Olivier Declaration");
- (3) Declaration of Jane Welch in Support of Renewed Petition for Revival of Unintentionally Abandoned Patent Application ("Welch Declaration");
- (4) Declaration of J. Georg Seka in Support of Renewed Petition for Revival of Unintentionally Abandoned Patent Application ("Seka Declaration"); and
- (5) Declaration of Justin K. Emerson in Support of Renewed Petition for Revival of Unintentionally Abandoned Patent Application ("Emerson Declaration").

I. Background

This application was filed by J. Georg Seka ("Seka") on October 26, 1999 on behalf of Onda Techno International Patent Attorneys of Gifu-City, Japan, ("Client"). Seka attended to all filing matters, on August 11, 2002 Seka filed an Information Disclosure Statement (IDS), and on March 28, 2001 Seka reported to the Client the first Office Action dated March 6, 2001. Thereafter, Seka transferred responsibility for this application to his partner, Kevin T. Lemond ("Lemond"), who responded to the first Office Action with an Amendment dated July 24, 2001. Lemond was responsible for and continued to handle all matters in connection with the ongoing prosecution of this application until he left TTC on February 28, 2006. Seka

had no involvement with this application and was not aware of any developments therein until he read the Notice of Abandonment dated January 25, 2007 (Exh. H). (Seka Declaration, paragraphs 1-2).

On November 12, 2002, a non-final Office Action (Exh. A) issued in which claims 19, 24 and 25 were allowed and claims 26-28, 30, 32 and 36 were rejected. Claims 29 and 31 were objected to because they depended from rejected parent claims, but they were not rejected over the prior art. In response to this Office Action, Lemond filed an Amendment dated March 12, 2003 which canceled claim 31 and added its subject matter (but not the subject matter of intervening claims 30 and 27 (Seka Declaration, paragraph 7)) to claim 26 to render claim 26, and therewith claims 27-30, 32-34 and 36 that depended from claim 26, allowable.

Lemond's attempt to place the application in condition for allowance was unsuccessful, and a Final Rejection dated April 25, 2003 (Exh. B) continued to allow claims 19, 24 and 25 but rejected claims 26-30, 32 and 36 (claim 31 having been canceled at that point because it had been incorporated in claim 26). The Final Rejection contained the note that "claim 31 was not incorporated; the claim language was changed".

In a letter dated May 28, 2003 (Exh. 1), Lemond reported the Final Rejection (Exh. B) to the Client and explained that the subject matter of claim 31 was not properly incorporated, as its language was changed, which required a slight modification of claim 26 in order to place it in condition for allowance. The letter noted that a response was due by July 25, 2003 and that the six-month statutory period for responding to the Office Action would end October 25, 2003. The Client responded with a letter dated June 6, 2003 (Exh. 2) and asked Lemond to file a suitable response by July 25, 2003. Lemond filed the response on September 25, 2003 in the form of an Amendment Under 37 CFR 1.116 (Exh. C) which included an amendment of claim 26 and stated in relevant parts:

In the previous amendment, applicants amended claim 26 to include the subject matter of claim 31. However, applicants neglected to include the subject matter of claim 30 (upon which claim 31 depended) and claim 27 (upon which claim 30 depended).

Accordingly, applicants have amended claim 26 to include the subject matter of claims 27 and 30. It is respectfully submitted that claim 26 is now allowable as indicated by the Examiner in the Office Action mailed November 12, 2002. Claims 32 and 36 depend on claim 26 and therefore are also allowable for at least the reasons claim 26 is allowable. (Exh. C, page 4, last paragraph)

With a letter dated September 26, 2003 (Exh. 3), Lemond forwarded to the Client a copy of the Amendment filed September 25, 2003 (Exh. C) and noted that in the event the Amendment were not entered, a request for continued examination or a new continuation, divisional or continuation-in-part application must be filed by October 25, 2003 to prevent the application from becoming abandoned. On October 16, 2003, TTC sent an invoice (Exh. 4) to the Client for services rendered in connection with the filing of the Amendment on September 25, 2003 (Exh. C).

As stated by Lemond in Exhibit C, he believed that he had fully responded to the Final Rejection and placed the application in condition for allowance by combining claim 26, which at this point already included claim 31, with intervening claims 27 and 30. An independent check of the Amendment (Exh. C) by Seka revealed, however, that Lemond only combined then-pending claim 26 (which already included claim 31) with claim 27, but not with claim 30, although claim 30 had been canceled in the Amendment (Exh. C). (Seka Declaration, paragraph 8).

As demonstrated above, the delay in filing an acceptable reply to the Final Rejection of April 25, 2003, which was due, at the latest, six months from that date, or by October 25, 2003, was a delay caused by Lemond's failure to correctly follow the course of action he mentioned to the client (Exh. 3), namely placing the application in condition for allowance by combining independent claim 26 with allowable dependent claim 31, including intervening claims 27 and 30. Lemond only partially did what was required, namely cancel dependent claims 27, 30 and 31, and he incorporated these claims in claim 26, but he omitted to add the language of claim 30 to claim 26.

The delay in filing a proper response to the Final Rejection (Exh. B) that led to the abandonment of this application was therefore not intentional, but a delay caused by a series of unintentional errors. The submitted evidence further demonstrates that there was no intent whatsoever on the part of the Client, Lemond and/or TTC to intentionally abandon the application. The evidence discussed above unequivocally demonstrates that, but for the omission to include intervening claim 30 in claim 26, the Amendment of September 25, 2003 (Exh. C) would have placed this application in condition for allowance and the abandonment of this application would have been avoided.

II. There Was No Intention to Abandon the Application Between the Filing of the Amendment on September 25, 2003 and the Date of the First Notice of Abandonment

On November 25, 2003, an Advisory Action (Exh. D) was mailed, and docketing records of TTC indicate that it was received by TTC. (Emerson Declaration, paragraph 5). However, this Advisory Action did not become part of the file and apparently became lost (Welch Declaration, paragraph 4). Neither Lemond's secretary, Lata Olivier ("Olivier"), nor Lemond saw this Advisory Action until 2007 (Olivier Declaration, paragraphs 7 and 8), as is further set forth below.

Advisory Actions are not docketed by TTC because by themselves they do not trigger a date on which a particular action needs to be taken. As a result, the Advisory Action of November 25, 2003 (Exh. D) does not appear on TTC's docket list for this application (Exh. J), although its receipt had been noted (Exh. K), as is set forth in the Emerson Declaration, paragraphs 4 and 6.

More than six months later, TTC received a first Notice of Abandonment dated June 17, 2004 (Exh. E) that stated that the application was abandoned in view of "applicants' failure to timely file a proper reply to the Office letter mailed on 4/25/03 (and 11/25/03)". The cover sheet of the Notice of Abandonment bore the stamp, applied at TTC, "Not Abandoned in Docket" and "Check Abandoned Status: 8/17/04". Olivier handed the Notice of Abandonment

together with the file to Lemond without noting that the Notice of Abandonment made reference to an Office letter dated 11/25/03.

Sometime prior to October 21, 2004, Lemond asked Olivier to refile the Amendment of September 25, 2003 (Exh. C) because the Notice of Abandonment (Exh. E) stated that the application was abandoned due to applicants' failure to file a proper reply to the Office Action of April 25, 2003 (Exh. B). Olivier recalls that at the time, Lemond mentioned to her that the Amendment of September 25, 2003 (Exh. C) must have become lost in the U.S. Patent Office because if it had been received the application would have been allowed. In view thereof, Lemond asked Olivier to refile Exhibit C, which Olivier did on October 21, 2004 (Exh. F).

There was no intention on the part of Lemond, the Client and TTC to abandon this application during the period from September 25, 2003, when Lemond filed Exhibit C, and October 21, 2004, when Lemond refiled Exhibit C as Exhibit F. The proper course for Lemond to follow during this time period was to file an RCE together with a proper Amendment in which claim 26 is combined with allowable claim 31 and intervening claims 27 and 30 or, following receipt of the Notice of Abandonment (Exh. E), to file a petition for the revival of an unintentionally abandoned application together with an RCE and Amendment to claim 26.

Lemond attempted to follow the correct course of action but committed several unintentional errors which made his bona fide attempts to place the application in condition for allowance, or to continue its prosecution to allowance, a failure.

Although Lemond thought he had placed the application in condition for allowance when he filed Exhibit C on September 25, 2003, and although he previously informed the Client that some further action had to be taken in the event the claims were not allowed, he continued his belief that Exhibit C, the September 25, 2003 Amendment, placed the application in condition for allowance. Matters were made worse by the fact that Lemond did not receive,

did not see and was therefore unaware of the Advisory Action of November 25, 2003 (Exh. D) which refused entry of Exhibit C.

Lemond's belief that Exhibit C placed the application in condition for allowance was apparently reinforced by the first Notice of Abandonment (Exh. E) as is evidenced by the fact that he refiled Exhibit C as Exhibit F on October 21, 2004 because he interpreted, albeit wrongly, the language in the first Notice of Abandonment (Exh. E) as meaning that the U.S. Patent Office never received Exhibit C. This is confirmed by his comment that "the Amendment of September 25, 2003 had apparently become lost in the USPTO because, if it had been received, the application would have been allowed" (Olivier Declaration, paragraph 6), which prompted him to file Exhibit F.

In connection with filing the response (Exh. F) to the Notice of Abandonment (Exh. E), Lemond committed additional errors by failing to file a Petition to revive in response to the first Notice of Abandonment and by apparently believing that the abandonment of the application would be retracted if the Amendment of September 25, 2003 (Exh. C) had been received by the U.S. Patent Office. The foregoing demonstrates that at all relevant times Lemond intended to advance the application to issue, which was unsuccessful due to errors he made, but it does not evidence any intention by either Lemond, the Client or TTC to abandon the application.

The delay in seeking the revival of this application between September 25, 2003 (when the application became abandoned) and October 21, 2004 (when Exh. F was filed) was not intentional, but was a delay caused by a series of further errors. The submitted evidence also shows that there was no intent on the part of Lemond, the Client or TTC to intentionally abandon this application.

III. There Was No Intent to Abandon the Application Between October 21, 2004, When Exhibit F Was Filed, and January 25, 2007, the Date of the Second Notice of Abandonment (Exh. H)

Lemond left TTC at the end of February 2006, some four months after he filed Exhibit F on October 21, 2004.

Nothing further happened in this case or to its status until the second Notice of Abandonment dated January 25, 2007 (Exh. H) was received by TTC. At that time the file was transferred to Seka because he became responsible again for this application after Lemond had left TTC. Ms. Welch, assistant and secretary to Seka, reviewed the file of this application before she handed it to Seka and noted that the first Notice of Abandonment (Exh. E) made reference to two Official Letters dated 4/25/03 (Final Rejection, Exh. B) and 11/25/03 (Advisory Action, Exh. D). Welch looked up Public PAIR for this application and noted that an Advisory Action dated November 25, 2003 (Exh. D) was mailed but was not part of the file. Welch retrieved a copy of Exhibit D from PAIR and noted thereon in her handwriting "TTC orig. missing", meaning that the original of that Advisory Action was not part of the file. She thereupon consulted with Ms. Olivier, who confirmed that she too had not before seen Exhibit D. (Welch Declaration, paragraphs 4-5; Olivier Declaration, paragraph 8). Welch then handed the file, including the second Notice of Abandonment (Exh. H) and the copy of Exhibit D retrieved by her, to Seka.

Seka reviewed the file and saw no indication in it that either the Client or Lemond ever expressed any intent to abandon the application. Seka contacted the Client and in a letter dated February 15, 2007 (Exh. 5) inquired whether there was any intent on the part of the Client to abandon the application. The Client responded in the negative (letter of February 20, 2007, Exh. 6). In a further letter dated March 14, 2007 (Exh. 7), Seka briefly summarized the developments that led to the abandonment of the application and forwarded to the Client a copy of a proposed Amendment that was to be filed with a Request for Continued Examination (RCE). The Client informed Seka that the Amendment was acceptable (letter of March 16, 2007, Exh. 8).

and on March 19, 2007 Seka filed a Petition for the revival of this application for unintentional abandonment together with an RCE and the required Amendment (Exh. I). With a letter dated March 23, 2007 (Exh. 9), Seka confirmed to the Client that the materials of Exhibit I had been filed.

There was no intention to abandon this application by Lemond, the Client or TTC during the period from October 21, 2004, when Exhibit F was filed, and January 25, 2007, the date of the second Notice of Abandonment (Exh. H). When Lemond left TTC, he believed he had done what was necessary to place the application in condition for allowance. In arriving at this belief, Lemond made several errors as set forth above. Had these errors not been committed, the Amendment of September 25, 2003 (Exh. C) or the same Amendment refiled on October 21, 2004 (Exh. F) with the then-required petition to revive would have placed this application in condition for allowance. All evidence demonstrates that neither Lemond nor the Client nor TTC had any intent to abandon this application.

As a result of the foregoing, the fact that this application became abandoned remained unnoticed at TTC until the receipt of the second Notice of Abandonment (Exh. H). When it was received, Seka immediately investigated why the case was abandoned, found out that it became abandoned and remained abandoned due to a series of errors on the part of Lemond, and after confirming with the Client that it too never had any intention to abandon the application, Seka prepared the required response to the Final Rejection of April 23, 2003 (Exh. B) in the form of an RCE, the required Amendment, and a petition for the revival of this application for unintentional abandonment, all of which should have been but were not filed by Lemond in response to the second Notice of Abandonment.

Thus, during the period of October 21, 2004 to the receipt of the second Notice of Abandonment of January 25, 2007 (Exh. H), there was no intent to abandon this application. Multiple errors were committed, but errors do not constitute an intent to abandon this application.

Following receipt of the second Notice of Abandonment, Seka ascertained that there never was any intent by Lemond, the Client or TTC to abandon this application, prepared the required RCE and an Amendment responsive to the Final Rejection of April 25, 2003, and filed the same with a petition to revive the unintentionally abandoned application less than two months from the date of the second Notice of Abandonment. This delay of six weeks between the date of the second Notice of Abandonment is a reasonable period for ascertaining the facts, communicating with the Client in Japan, and preparing the Amendment and the original petition for the revival of this application.


Accordingly, the delay between October 21, 2004 (when Exh. F was filed) and March 19, 2007 (when the RCE, the Amendment and the original petition for revival were filed) was not intentional and during this time there was no intention on the part of Lemond, the Client or TTC to abandon this application.

IV. Conclusion

Although Lemond committed several errors which led to the abandonment of this application, the delays which led to the abandonment of this application and the delay in bringing the original petition to revive were not intentional delays. There was also never an intention by anybody associated with this application to abandon it. The evidence submitted herewith identifies the errors and how they arose. However, there is no evidence which would suggest that anybody associated with this application ever entertained the thought of abandoning this application, much less did anyone associated with this application ever take any action to abandon this application, or which could be interpreted as constituting such an intent.

In view thereof, applicants request that this Petition be granted at an early date.

Respectfully submitted,


J. Georg Seka
Reg. No. 24,491

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